

ESTTA Tracking number: **ESTTA178050**

Filing date: **12/03/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91120453
Party	Plaintiff HEARST COMMUNICATIONS, INC. and Hearst Magazines Property, Inc.
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Date	12/03/2007
Attachments	Wilson - Hearst's Responses to Second Cross-Examination.pdf (14 pages) (552910 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Hearst Communications, Inc. and)	
Hearst Magazines Property, Inc.,)	
)	
Opposers,)	
)	Opposition No. 91120453
v.)	
)	
Charles Browning Wilson,)	
)	
Applicant.)	

**OPPOSERS' RESPONSES TO APPLICANT'S SECOND
WRITTEN CROSS EXAMINATION**

Opposers Hearst Communications, Inc. ("HCI") and Hearst Magazines Property, Inc. ("HMPI") (collectively "Opposers"); submit the following responses and objections to Applicant's Second Written Cross-Examination:

OBJECTIONS

Opposers object to the definition of "Opposers' Mark" as unduly restrictive on the grounds that the mark underlying Reg. No. 1843656 is only one of two registrations asserted by Opposers in this litigation (the other is Reg. No. 0630028) and that the Opposers' Notice of Opposition additionally references Opposers' common law rights in various other marks.

Opposers object to the definition of "Applicant's Mark" as unduly broad on the ground that the definition does not restrict the referenced marks with regard to Applicant's goods and services; as argumentative on the ground that it asserts COSMO, COSMO.COM, and "any mark similar thereto used by Applicant" are Applicant's marks; and as inaccurate on the ground that Applicant claims it is the owner of the marks COSMO, COSMO.COM, and any mark similar thereto used by Applicant.

Opposers object to Applicant's Second Written Cross-Examination questions in their entirety and to each question to the extent that the information sought is protected by the attorney-client privilege or the work product doctrine or would disclose the mental impressions, conclusions, opinions, or legal theories of counsel and, as such, are protected.

Opposers object to Applicant's Second Written Cross-Examination questions in their entirety and to each question to the extent that they attempt to impose obligations upon Opposers inconsistent with or greater than the Federal Rules of Civil Procedure or the Trademark Rules of Practice.

Opposers object to Applicant's Second Written Cross-Examination questions in their entirety and to each question to the extent that they seek disclosure of confidential or proprietary business information or trade secrets of Opposers.

To the extent that Applicant's Second Written Cross-Examination questions are unlimited in time, Opposers object that the requests are overbroad and unduly burdensome or seek information not within the possession, custody, or control of Opposers.

To the extent that Applicant's Second Written Cross-Examination questions seek information regarding activity outside the United States, Opposers object on the ground that such information is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. The parties' claims arise solely out of the trademark laws of the United States, and extraterritorial activities are irrelevant to those claims.

By responding to Applicant's Second Written Cross-Examination questions, Opposers do not waive or intend to waive, but instead preserve, all objections as to the competency, relevancy, materiality, and admissibility of the responses or the subject matter thereof.

Opposers reserve the right to supplement or amend these responses based upon later recollections, the recollections of persons presently unidentified or unavailable, or the discovery of additional documents or information.

Question No. 1: Given that Opposers have explicitly abandoned their claim of any possible confusion between Applicant's Mark and USPTO Reg No 1843656. And further given that Opposers do not have any currently valid PTO trademark registrations for the specific phrase "Cosmo", please identify all information relevant to any claim by Opposers that Applicant's mark is likely to cause confusion with Opposers' trademark Reg. No. 1,685,161.

Response: Opposers object to the characterization that they have abandoned their position that there is a likelihood of confusion between Applicant's Mark and Opposers' Mark, Reg. No. 1843656. Opposers further object to this question to the extent that it is meant to suggest that Opposers necessarily must have federal trademark registrations for the specific phrase "COSMO" to establish rights to the COSMO mark standing alone. Subject to these and the General Objections, Opposers direct Applicant to the substantial evidence of actual confusion produced by Applicant itself and already submitted to the Board under cover of Opposers' initial notice of reliance. Opposers further respond that consumers viewing Applicant's mark and correctly assuming that it corresponds to a domain name are likely to believe that the domain name is one used by Opposers to provide online content from the magazine sold under Opposers' registered COSMOPOLITAN mark. Because of the public's tendency to view COSMOPOLITAN and COSMO as equivalents, Applicant's Mark not only is likely to be confused with Opposers' COSMO mark, but also is equally likely to be confused with HCI's registered COSMOPOLITAN.COM mark. This likelihood of confusion is exacerbated by consumers' awareness of Opposers' family of the other

registered COSMO GIRL and COSMOPOLITAN marks described in the First and Second
Rodgers Declarations, which entitles HCI to an expanded scope of protection for its marks.

Question No. 2: Given that Opposers have explicitly abandoned their claim of any possible confusion between Applicant's Mark and USPTO Reg No 1843656. And further given that Opposers do not have any currently valid PTO trademark registrations for the specific phrase "Cosmo", please identify all information relevant to any claim by Opposers that Applicant's mark is likely to cause confusion with Opposers' trademark Reg. No. 1,911,389.

Response: Opposers refer Applicant to their objections and response to Question No.

1 above.

Question No. 3: Given that Opposers have explicitly abandoned their claim of any possible confusion between Applicant's Mark and USPTO Reg No 1843656. And further given that Opposers do not have any currently valid PTO trademark registrations for the specific phrase "Cosmo", please identify all information relevant to any claim by Opposers that Applicant's mark is likely to cause confusion with Opposers' trademark Reg. No. 1,855,579.

Response: Opposers refer Applicant to their objections and response to Question

No. 1 above.

Question No. 4: Given that Opposers have explicitly abandoned their claim of any possible confusion between Applicant's Mark and USPTO Reg No 1843656. And further given that Opposers do not have any currently valid PTO trademark registrations for the specific phrase "Cosmo", please identify all information relevant to any claim by Opposers that Applicant's mark is likely to cause confusion with Opposers' trademark Reg. No. 2,235,977.

Response: Opposers refer Applicant to their objections and response to Question

No. 1 above.

Question No. 5: Given that Opposers have explicitly abandoned their claim of any possible confusion between Applicant's Mark and USPTO Reg No 1843656. And further given that Opposers do not have any currently valid PTO trademark registrations for the specific phrase "Cosmo", please identify all information relevant to any claim by Opposers that Applicant's mark is likely to cause confusion with Opposers' trademark Reg. No. 2,304,917.

Response: Opposers refer Applicant to their objections and response to Question No. 1 above.

Question No. 6: Opposers recently filed USPTO application Serial No. 77137373, on March 26, 2007, which claims first use of “COSMO” on March 29, 2002, in Int’l class No. 41, and contains a statement of use, as follows: “Publication of Electronic Magazine Portions and Publication of Electronic Magazine Articles and Illustrative Materials in the Fields of Personal Relationships, Beauty and Fashion, Health and Fitness, and Personal Hygiene”. Please indicate how Opposers can claim first use in commerce of the phrase “Cosmo” in Int’l class 41 in the herein proceeding prior to Applicant’s use, while simultaneously certifying to the USPTO in their application Serial No. 77137373 that their first use of commerce of “Cosmo” in Intl class 41 was after Applicant’s first use.

Response: Opposers direct Applicant to Opposers’ response to Question No. 5 to Applicant’s Written Cross-Examination and incorporate Opposers’ response herein.

Opposers reiterate that although its date of first use for the services recited in Application Serial No. 77/137,373, Opposers’ rights to the COSMO mark predate that of Applicant’s Mark. Third party uses of COSMO to refer to Opposers’ *Cosmopolitan* magazine occurred as early as 1974 and Opposers themselves began using the term COSMO as early as 1964.

Question No. 7: Paragraph 4 of the Second Declaration of Stephen Rodgers, states that “Applicant is correct that this registration lapsed in 2001, HCI has at no point discontinued use of marks consisting in whole or in part of the word COSMO, much less abandoned its trademark rights to the world.” Please explain why Opposer has failed to file a petition to renew such mark and/or any of the other marks previously owned by Opposers for the exact phrase “Cosmo” which have been canceled by the USPTO and/or abandoned by Opposers, and instead, are attempting to register a new trademark for “Cosmo” under serial Nos. 77195652 and 77137373.

Response: Subject to the General Objections, Opposers object to the characterization of the filing of a Section 8 declaration as “a renewal” and to the reference in the question to the “other marks previously owned by Opposers for the exact phrase ‘COSMO’ which have been cancelled by the USPTO and/or abandoned by Opposers.” Opposers further object to the suggestion underlying this question that they have abandoned

rights to any of the “COSMO” marks they use, including but not limited to those marks recited in paragraphs 5-6 of the Second Declaration of Stephen Rodgers. Opposers also object to the suggestion that their COSMO marks have been cancelled, rather than to the cancellation of Opposers’ Registration No. 1843656.

Subject to these and the General Objections, Opposers cannot identify the reason a Section 8 declaration was not filed for Reg. No. 1843656. However, as shown in the chart below, the goods and services covered by the recently filed applications for COSMO under Serial Nos. 77/195652 and 77/137373 are different from those goods covered by Reg. No. 1,843,656. As a result, these applications are not a substitute for Reg. No. 1,843,656.

Mark	Registration or Application Number	Goods and Services
COSMO	1,843,656	“Cosmetic bags sold empty, umbrellas, leather key fobs, key cases, credit card holders and traveling bags” in International Class 18.
COSMO	77/195,652	“Magazines featuring women’s service, beauty, health, and human relationship,” in International Class 16.
COSMO	77/137,373	“Providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationship, beauty and fashion, health and fitness, and personal hygiene rendered by means of a global computer network,” in International Class 42.

Question No. 8: Paragraph 8 of the Second Declaration of Stephen Rodgers, states that: “[T]he cosmo.com domain was not in use by Applicant’s predecessor at the time of the articles publication. Consequently, there would have been no reason for HCI or HMPI to have challenged the registration of the domain at that time”. Please explain the basis for Opposer’s assertion that the identity of the then owner of the cosmo.com mark in or about 1996 or that owner’s use of the mark was relevant to any standards applicable to Opposers

potential claims in a hypothetical ICANN proceeding against such predecessor owner of the cosmo.com uniform resource locator.

Response: Opposers object to this question on the ground that ICANN proceedings were not available in 1996. Subject to this objection, Opposers respond that to bring a UDRP proceeding, a complainant must show, *inter alia*, that the domain name is being used and/or registered in “bad faith.” Some UDRP panels have required bad faith “registration *and use*.” Because the previous owner of cosmo.com was not using the domain name in connection with an active site, and at the time, there was no evidence that the registrant registered the domain in bad faith (i.e., by trying to extort money from Opposers, by diverting or attempting to divert customers using a confusingly similar name, or registering a significant number of suspicious domain names, etc.), there was no reason for Opposers to initiate such a proceeding.

Question No. 9: Given Opposers’ failure to commence any action pursuant to the Lanham Act and/or any ICANN proceeding seeking to obtain ownership of the cosmo.com uniform resource locator both prior and after Applicant’s obtaining ownership of cosmo.com, please identify how Opposers’ rights to any of Opposers’ unregistered marks should be considered as a basis for any claim that such unregistered marks are superior to Applicant’s Mark.

Response: Opposers object to the extent that Opposers’ decision not to commence any action under the Lanham Act and/or ICANN proceeding is not relevant to Opposers’ right to its marks. Opposers direct Applicant to Opposers’ response to Question No. 10 in Applicant’s Written Cross-Examination and hereby incorporate Opposers’ response herein. Opposers further respond that Opposers could not obtain ownership of the cosmo.com domain name through any action pursuant to the Lanham Act before Applicant obtained ownership and began operating its site on cosmo.com because the designation was not being

used in commerce as required by Sections 32 and 43 of the Lanham Act, 15 U.S.C. §§ 1114, 1125.

Question No. 10: Please identify the date of first use of each and every unregistered mark identified in paragraphs 5 and 6 of the Second Declaration of Stephan Rodgers as well as any other purported unregistered marks which Opposers may claim are likely to cause confusion if Applicant's mark proceeds to registration.

Response: Opposers refer Applicant to the chart below, which includes the date of first use of their registered and unregistered "COSMO" marks that were identified in paragraphs 5 and 6 of the Second Declaration of Stephen Rodgers.

Section	Date of First Use	Goods and Services	Registration or Application Number
Cosmo Quiz	5/1997	"Section of a magazine featuring topics such as relationships" in International Class 16.	2,969,534
Cosmo Surveys	3/29/2002	Section of iVillage hosted website	
Cosmo Faq's	3/29/2002	Section of iVillage hosted website	
Cosmo Kama Sutra	12/2004	Book	
Cosmo Fashion	11/29/2002	Section of iVillage hosted website	
Connect With Cosmo	3/29/2002	Section of iVillage hosted website	
Be In Cosmo	4/2/2006	Section of iVillage hosted website Section of current website	
Free Stuff From Cosmo	7/1/2005	Section of iVillage hosted website	
Cosmo Exclusives	11/4/2002	Section of iVillage hosted website	
Cosmo For Your Guy	8/4/2006 (web)	Magazine section of iVillage hosted website	
Get Cosmo Headlines	1/1/2006	Section of iVillage hosted website	
Make Cosmo Your Homepage	2/6/2003	Section of iVillage hosted website	
Make A Great Recipe From Cosmo Radio	11/4/2006	Section of iVillage hosted website	
Sporting A Style You Found In Cosmo?	6/10/2006	Section of iVillage hosted website	

Section	Date of First Use	Goods and Services	Registration or Application Number
Add Cosmo To Your Myspace	6/10/2006	Section of iVillage hosted website	
Get Cosmo Updates	6/1/2007	Section of current website	
Cosmo Mobile	8/1/2005	“Communications by mobile phones; Mobile media services in the nature of electronic transmission of entertainment media content; Wireless communications services, namely, transmission of graphics to mobile telephones” in International Class 38.	77/291,126
Cosmo Radio	3/1/2006	Advertised on web and in print magazine	
Cosmo Promo Hot Spot	7/1/2005	Section of current website and magazine	
Cosmo Media Kit	8/5/2004	Section of iVillage hosted website; section of current website	
Cosmo Commandments	11/30/2001	“Magazine departments in the field of advice for relationships, health, fitness, beauty, and finance, published monthly and at other periodic intervals” in International Class 16	77/112,303
Cosmo Gyno	1/31/2001	“Magazine departments in the field of health, and fitness published monthly and at other periodic intervals” in International Class 16	77/114,876
Cosmo Hair	2/28/2001	“Magazine departments in the field of fashion, beauty, beauty product reviews, and celebrity news, published monthly and at other periodic intervals” in International Class 16	77/116,031

Section	Date of First Use	Goods and Services	Registration or Application Number
Cosmo Kisses	5/22/2007	"Entertainment services, namely, providing on-line computer games" in International Class 41	77/291,131
Cosmo Weekend	1/31/2001	"Magazine departments in the field of entertainment, beauty, health, human relationships, published monthly and at other periodic intervals" in International Class 16	77/113,826
Daily Cosmo	5/22/2007	"Providing on-line publications in the nature of magazines featuring photos, video, and prose in the field of personal relationships, beauty and fashion, health and fitness, celebrity news, and astrology" in International Class 41	77/291,124
Club Cosmo	1/1/1999	"Compact discs featuring music" in International Class 9	77/301,657
Cosmo	2/15/2007	"Pillows" in International Class 20	77/132,014
Cosmo	3/29/2002	"Publication of electronic magazine portions and publication of electronic magazine articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, and personal hygiene" in International Class 16	77/137,373
Cosmo	5/8/2007	"Magazines featuring information on women's services, beauty, health, and human relationships" in International Class 16	77/195,652
Cosmolicious	5/22/2007	"Providing on-line publications in the nature of magazines featuring photos, video, and prose in the field of personal relationships, beauty and fashion, health and fitness, celebrity	77/291,121

Section	Date of First Use	Goods and Services	Registration or Application Number
		news, and personal hygiene” in International Class 41	

Question No. 11: Please identify all efforts by Opposers’ to direct its customers away from cosmo.com and to utilize its cosmopolitan.com, cosmomag.com or cosmogirl.com uniform resource locators.

Response: Opposers respond that because they do not own cosmo.com, they cannot redirect customers that arrive at Applicant’s website to their other uniform resource locators (“URLs”). Nevertheless, Opposers use keyword advertising in connection with the “COSMO” mark on search engines such as Google, Yahoo, and MSN. For example, when customers search for “COSMO” on Google, Cosmopolitan.com is the first result of both the sponsored links and natural search results. Similarly, customers searching for “COSMOPOLITAN” will also receive the same results in response to a search for this term.

Question No. 12: Identify all goods currently sold by Opposers which utilize the exact phrase “Cosmo” in any manner.

Response: Opposers direct Applicant to Opposers’ response to Question Nos. 5-6 in Applicant’s Written Cross-Examination and Question No. 10 above, which Opposers incorporate herein.

Question No. 13: Identify all services currently rendered by Opposers which utilize the exact phrase “Cosmo” in any manner.

Response: Opposers direct Applicant to Opposers’ response to Question Nos. 5-6 in Applicant’s Written Cross-Examination and Question No. 10 above, which Opposers incorporate herein.

Question No. 14: Please identify the relevance of paragraphs 9 - 12 of Second Declaration of Stephen Rodgers given that Applicant has already admitted that he did not initiate, but has admitted that he personally edited his Wikipedia page.

Response: Opposers respond that Paragraph 9 of the Second Declaration of Stephen Rodgers is relevant to show the public's tendency to view COSMOPOLITAN and COSMO as equivalents. Paragraphs 10-12 are relevant to show that Applicant has previously edited the Wikipedia definition for "Cosmo."

Question No. 15: Identify all instances where Opposers have made edits, alterations and/or any changes to any Wikipedia page referencing any unregistered mark identified by Opposers in this action.

Response: Opposers respond that they have never made edits, alterations, and/or changes to any Wikipedia page referencing any unregistered mark identified by Opposers in this action.

Dated: December 3, 2007

Respectfully submitted,
/Theodore H. Davis Jr./
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VERIFICATION

My name is Stephen Rodgers. I am Vice-President Administration of Hearst Magazines Division of Hearst Communications, Inc. ("HCI") and I am authorized to verify Opposers' Responses to Applicant's Second Cross Examination on behalf of HCI. The information set forth in this declaration is based upon my personal knowledge and upon documents maintained by employees within my supervision. I have reviewed Opposers' Responses to Applicant's Second Written Cross-Examination and state that they are true and correct to the best of my knowledge.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, declares that the facts set forth in this declaration are true; all statements made of his or her own knowledge are true; and that all statements made on information and belief are believed to be true.



Stephen Rodgers

Date: Nov. 30, 2007

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CERTIFICATE OF SERVICE

I hereby certify that on this date, I served the foregoing **OPPOSERS' RESPONSES TO APPLICANT'S SECOND WRITTEN CROSS-EXAMINATION**, upon Applicant by depositing a copy thereof in the United States mail as first class mail, postage pre-paid, addressed as follows:

Robert M. Steckman, Esq.
The Law Office of Robert Steckman, P.C.
111 John Street, 8th Floor
New York, New York 10038

This the 3rd day of December, 2007.

/Lauren T. Estrin/
Lauren T. Estrin